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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,927	07/26/2001	Hai Lin	P/3491-55	7356

2352 7590 09/17/2004

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EXAMINER

CHEA, PHILIP J

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/915,927

Applicant(s)

LIN, HAI

Examiner

Philip J Chea

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/26/2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-10 have been examined.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 089115204, filed on 07/29/2000.

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification or in an application data sheet (37 CFR 1.78(a)(2) and (a)(5)). The specific reference to any prior nonprovisional application must include the relationship (i.e., continuation, divisional, or continuation-in-part) between the applications except when the reference is to a prior application of a CPA assigned the same application number.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

- Note page 1, lines 15-18

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because:

Art Unit: 2153

- reference character "4" has been used to designate both "Store the mail" and "download the mail";
- reference character "6" has been used to designate both "Return the mail" and "Return the mail automatically and delete the mail from the server";
- reference character "8" has been used to designate both "Store the mail" and "download the mail"; and
- reference character "10" has been used to designate both "Store the mail" and "download the mail".

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

- Fig. 1 note references 1-12; and
- Fig. 2 note references 1-12.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities:

- Note page 4, lines 8 and 12, "trsucode" is apparently trustcode;
- Note page 5, lines 3 and 11, "trsucode" is apparently trustcode; and

Art Unit: 2153

- Note page 8, line 3, "come" is apparently "comes".

Appropriate correction is required.

Claim Objections

7. Claim 1 objected to because of the following informalities:

- Note line 3, "to be or not to be", improper grammar;
- Note line 17, "will be" claims should be written in present tense.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Note lines 9, "compelled" is indefinite claim language because it fails to disclose exactly what the mail sender is supposed to do; and
- Note line 14, "in some other way which should" is indefinite claim language because it fails to disclose how to send the mail, and if it must include the trustcode.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2153

11. Claims 1-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Heiner (U.S. 6,112,227) in view of Greenstein (U.S. 6,266,692).

As per claim 1, Heiner discloses a method of anti-spam, as claimed, comprising:

- a trustlist storing a plurality of e-mail sender's addresses (see column 3, lines 15-22);
- a web-based mail sending web site, where sender registers by visiting the recipient's trustweb and filling out a web page form (see column 4, lines 3-6). Heiner does not expressly disclose "sending a mail to the recipient on web basis". Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Heiner. Motivation to do so would be because email is a popular way of sending information over the internet;
- registering a sender automatically after a mail is successfully sent to recipient (see column 3, lines 19-22); and
- permitting sender to send mail without being restricted (see column 3, lines 22-25, where "without being restricted" is implied by having the message sent to the recipient without being examined).

Although Heiner discloses substantial features of the claimed invention (discussed above), he fails to directly disclose a trustcode being an optional character string that can be changed at the recipients will. Nonetheless, this feature is well known in the art and would have been an obvious modification of the system disclosed by Heiner, as evidenced by Greenstein.

In an analogous art, Greenstein discloses a method of blocking unwanted email using a header based passcode (see column 3, lines 41-49) which can be changed by the recipient (see column 4, lines 38-42, where updates of passcodes imply that they can be changed by the recipient).

Given the teaching of Greenstein, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Heiner by employing the header based passcodes, such as disclosed by Greenstein, in order to block unwanted mail.

As per claims 2 and 3, although Heiner discloses substantial features of the claimed invention (discussed above), he fails to directly disclose the trustcode being stored on the recipients mail server and web server. Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Heiner, as evidenced by Greenstein. Greenstein discloses setting the trustcode in the recipients e-mail server for checking if the trustcode is enclosed (see column 3, lines 45-49). Given the teaching of Greenstein, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Heiner by employing the trustcode stored on the recipients mail server, such as disclosed by Greenstein, in order to let the server manage the burden of searching through trustcodes and leaving it up to the engineer as a design choice. It also would have been obvious to a person having ordinary skill in the art that the trustcode could be stored on any server, such as a web server.

In considering claim 3, Heiner in view of Greenstein fail to disclose the trustcode being set at the recipients client system. Nonetheless, this feature is well known in the art and would have been an obvious modification because it is a design choice whether the trustcode be checked remotely or locally.

As per claims 4 and 5, Heiner in view of Greenstein discloses setting the trustlist (trustlist = accept list) on the destinations mail server (see Heiner column 3, lines 15-25). In considering claim 5, Heiner fails to directly disclose the trustlist being set on the recipient's client system. Nonetheless, this feature is well known in the art and would have been an obvious modification because it is a design choice whether the trustlist be checked remotely or locally.

As per claims 6 and 7, Heiner in view of Greenstein fail to disclose the trustweb set to a single domain (claim 6) or different domain names (claim 7). Nonetheless, these features are well known in the art and would have been an obvious modification to the system as disclose by Heiner and Greenstein. A person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Heiner in view of Greenstein by employing the single domain name (claim 6) or different domain names (claim 7), because it is a design choice for the number of trustwebs that the recipient wants on the internet.

Art Unit: 2153

As per claim 8, Heiner in view of Greenstein fail to disclose default content reminding the mail sender the way of "visiting trustweb and sending online". Nonetheless, these features would have been obvious to a person having ordinary skill in the art. It is well known in the art that instructions for registering and using a service of a website for the first time are provided by sending instructions through emails. The motivation for doing so is because email is a popular, and efficient way to communicate over the Internet.

As per claim 9, although the system disclosed by Heiner shows substantial features of the claimed invention, it fails to disclose treating the trustcode as an extra item and arranging it in the e-mail format. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Heiner as evidenced by Greenstein. Greenstein discloses an email client configured to support an additional passcode field (see column 4, lines 27-31). Given the teaching of Greenstein, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Heiner by treating the trustcode as an extra item, such as disclosed by Greenstein, in order to provide the functionality of blocking unwanted e-mail using a header-based password (see Greenstein column 4, lines 18-26).

As per claim 10, Heiner in view of Greenstein fail to disclose taking the trustcode as the end code of a username in an e-mail address and inserting a "-" for splitting between the username and the trustcode to serve as a new username to form a new e-mail address. Nonetheless, this feature would have been obvious to a person having ordinary skill in the art. It is well known in the art that symbols such as a period, comma, slash, or colon, can be used to separate two names. The motivation to use a separating character would be to distinguish between the two names that are combined into one.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shuster, Brian Mark

US 20020023135

Art Unit: 2153

McCormick, William B. et al.	US 6023723
Heiner, Jeffrey Nelson	US 6112227
Fleming, III, Hoyt A.	US 6249805
Greenstein, Bret A.	US 6266692
McCormick, William B. et al.	US 6421709
Kirsch, Steven T.	US 6546416

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J Chea whose telephone number is 703-605-1202. The examiner can normally be reached on M-F 7:45-4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 703-305-4792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Philip J Chea
Examiner
Art Unit 2153

PJC

